

REMARKS

The Examiner is thanked for the performance of a thorough search. Applicants note with appreciation that the Examiner has indicated that Claim 11 is allowable if rewritten in independent form.

By this amendment, Claims 1, 3, 12, 19, 21, 30, 37, 38 and 40 have been amended. No claims have been added or deleted. Hence, Claims 1-42 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability. All issues raised in the Office Action mailed August 5, 2003 are addressed hereinafter.

1. REJECTION OF CLAIMS 1-10 and 12-18 UNDER 35 U.S.C. § 102(e)

Claims 1-10 and 12-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Whitmarsh*, U.S. Patent Application No. US 2002/0101608. It is respectfully submitted that Claims 1-10 and 12-18, as amended, are patentable over *Whitmarsh* for at least the reasons provided hereinafter.

A. CLAIM 1

Applicant notes that the Examiner interpreted the first, second and third paper sources, that are recited in Applicant's Claim 1, as not necessarily referring to different paper sources. Additionally, the Examiner interpreted the first, second and third page ranges, that are recited in Applicant's Claim 1, as not necessarily referring to different page ranges. Applicants believe that the denotation of first, second and third paper

sources and page ranges clearly indicates that the sources are different and the ranges are different. However, in light of the Examiner's rejection, Applicants have amended Claim 1 so that it further emphasizes that different paper sources and different page ranges are recited. Therefore, Claim 1, as amended, recites the following method:

“A method for printing an electronic document, the method comprising:
selecting a first paper source for printing a first page range of one or more pages of said electronic document;
selecting a second paper source for printing a second page range of one or more pages of said electronic document, wherein said second paper source is a paper source different from said first paper source and wherein said second page range is a page range different from said first page range;
selecting a third paper source for printing a third page range of one or more pages of said electronic document, wherein said third paper source is a paper source different from said first paper source and different from said second paper source and wherein said third page range is a page range different from said first page range and different from said second page range; and
transmitting, to a printing device, information that identifies said first, second and third paper sources for printing said first, second and third page ranges of one or more pages of said electronic document.” (text introduced by current amendment is underlined)

The Examiner's rejections were based on an interpretation of Claim 1 under which the first, second and third paper sources were the same, and under which the first, second and third page ranges were the same. However, given the amendments set forth herein, Claim 1 cannot be interpreted so broadly. Thus, it is respectfully submitted that Claim 1, when interpreted in light of the amendments made herein, overcomes the Examiner's rejection. In particular, Claim 1 includes several limitations that are not taught or suggested by *Whitmarsh*. Specifically, Claim 1 requires:

“selecting a second paper source for printing a second page range of one or more pages of said electronic document, wherein said second

paper source is a paper source different from said first paper source and wherein said second page range is a page range different from said first page range;

Additionally, claim 1 requires:

“selecting a third paper source for printing a third page range of one or more pages of said electronic document, wherein said third paper source is a paper source different from said first paper source and different from said second paper source and wherein said third page range is a page range different from said first page range and different from said second page range” and

These limitations, among others, are not taught or suggested by *Whitmarsh*.

Whitmarsh merely teaches the selection of a single paper source/characteristic and the selection of a single page ranges. See Office Action at page 3, as well as Figures 7 and 9 of *Whitmarsh* (showing a screen with fields for selecting a single paper source or a single page range). *Whitmarsh* does not teach selecting first and second paper sources or first and second page ranges, as claimed in claim 1.

It is therefore respectfully submitted that each and every limitation of Claim 1 is not taught or suggested by *Whitmarsh*. Therefore, *Whitmarsh* does not anticipate claim 1.

B. CLAIMS 2-10 and 12-18

Claims 2-10, and 12-18 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-10 and 12-18 are patentable over *Whitmarsh* for at least the reasons set forth herein with respect to Claim 1.

Furthermore, it is respectfully submitted that Claims 2-10 and 12-18 recite additional limitations that independently render them patentable over *Whitmarsh*. Given

the fact that the amendments herein have rendered the rejection of Claim 1 and dependent Claims 2-10 and 12-18 moot, arguments concerning the additional limitations of the dependent claims are not set forth at this time. Nevertheless, Applicants reserve the right to present such arguments at a later time in the prosecution of this application, if necessary.

In view of the foregoing, it is respectfully submitted that Claims 1-10 and 12-18 are patentable over *Whitmarsh*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-10 and 12-18 under 35 U.S.C. § 102(e) as being anticipated by *Whitmarsh* is respectfully requested. Additionally, because claims 19-42 have not yet been cancelled, Applicants note that, at least for the reasons stated above in respect of Claim 1, Claims 19-42 are also not anticipated by *Whitmarsh*. In this regard, Applicant notes that independent Claims 3, 12, 19, 21, 30, 37, 38 and 40 have been amended in a manner similar to Claim 1, so that Claims 3, 12, 19, 21, 30, 37, 38 and 40 further emphasize that the paper sources and page ranges recited are different.

2. FINAL RESTRICTION REQUIREMENT

Applicants note that the Examiner has made the requirement for restriction in this case final. However, Applicants maintain that the requirement for restriction is improper in this case. Therefore, Applicants have filed a Petition Under 37 CFR § 1.144 to request that the Honorable Commissioner for Patents review the final requirement for restriction that has been entered in this case.

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

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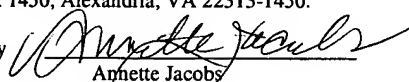
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

on November 3, 2003 by


Annette Jacobs